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Application No.: 10/816766

Docket No.: 05129-00079-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:
Pierre Dournel et al.

Application No.: 10/816766

Art Unit: 1751

Filed: April 2, 2004

Examiner: J. R. Hardee

For: COMPOSITIONS COMPRISING 1,1,1,3,3-
PENTAFLUOROBUTANE AND USE OF
THESE COMPOSITIONS

AMENDMENT IN RESPONSE TO NON-FINAL OFFICE ACTION

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Déar Sir:

INTRODUCTORY COMMENTS

In response to the Office Action dated September 30, 2004, please amend the above-identified U.S. patent application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 6 of this paper.

221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the reference itself must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicant disagrees with the Examiner why one skilled in the art with the knowledge of the reference would selectively modify the reference in order to arrive at the applicant's claimed invention. The Examiner's argument is clearly based on hindsight reconstruction. For the above reasons, this rejection should be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

A one month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05129-00079-US from which the undersigned is authorized to draw.

Respectfully submitted,

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